

PATENT
Atty. Dkt. No. 065691-0327
Appl. No. 10/619,905

REMARKS

Applicants respectfully request reconsideration of the present application.

I. Disposition of the Claims

Claims 41-56 are canceled without prejudice or disclaimer. Claims 1-40 were previously canceled without prejudice or disclaimer.

Claims 57-68 are new and correspond to the elected invention. Compare claim 57 with claim 49 previously presented.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

II. Information Disclosure Statement (IDS)

Examiner indicated that document no. A16 does not include the date of publication and was therefore placed in the file but not considered on its merits. Office action, p. 2. Filed with this response is an IDS submitting and disclosing document A16 and its publication date of 1995.

Furthermore, an English language translation of the disclosure is provided for Piascledine 300, which subject matter is described starting in column 2 near the bottom of page 1163.

The present application is a continuation of 09/868,989, filed 10-02-2001, now abandoned, which is the national stage of international application PCT/FR99/03272, filed 12-23-1999, published in a non-English language. One other U.S. application claims to benefit '989 application, namely, U.S. Application No. 10/619,686, filed 07-15-2003.

III. 35 U.S.C. § 112, first paragraph.

Claims 44-45 were rejected as failing to comply with the written description requirement. Office action, p. 3. It is believed that the Examiner objects to the use of the word derivative as used in the term “furan derivative (fraction H).” Along these lines, the Examiner stated that “applicant has not provided a description of the structures of a representative number of compounds which are derivatives nor a description of the chemical and/or physical characteristics of a representative number of such compounds nor a description of how to obtain a representative number of said specific compounds.” Office action, p. 3. These claims have been canceled. So as to these claims, the rejection should be withdrawn. Furthermore, the new claims avoid the issue for the following reasons.

Even if an applicant must convey to those of ordinary skill in the art that as of the filing date sought her or she possessed the claimed invention, *Vas-cath, Inc. v. Mahurkur*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111 (Fed. Cir. 1991), one of ordinary skill in the art “comes to the patent with a knowledge of what comes before.” *Falkner v. Inglis*, 448 F.3d 1357, 1366, 79 USPQ2d 1001 (Fed. Cir. 2006).

The Examiner’s restriction requirement is evidence that the term “furan derivative” was known. It is fundamentally unfair for the Examiner to use the term “furan derivative” in the restriction requirement as a point of delineation, Office action of 08-23-2006, p. 3, (class 514, subclass 449 bridging paragraph), and follow that response with an action urging that the term “furan derivatives” has no written description support, because one of ordinary skill in the art would not know what the term “furan derivative” means. The Examiner said that the term denotes an accepted class. Office action 08-23-2006, p. 3. (“Further, as shown by the following classifications, the majority of the combinations encompassed by the present claims have required a separate status in the art.”)

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As further evidence that the term "furan derivative" was known, Applicants submit a reference supporting the fact that the furan derivatives of avocado oil have been described, in particular, in *Farines, M. et al.*, 1995, J. of Am. Oil Chem. Soc. 72:473-76 (enclosed for consideration). As a result, this rejection should not be made against the present claims.

IV. 35 U.S.C. § 112, second paragraph.

Claims 44-45 were rejected for reciting the terms "furan derivatives (fraction H)" and the phase "fatty alcohols (fraction I)." Office action, p. 4. According to the rejection, these terms render the claim indefinite, because it is unclear whether or not the limitations following the parenthesis are part of the claimed invention. Office action, p. 4. This rejection is avoided, because the present version of the claims does not recite either term. Thus, the present rejection should not be made against the present claims.

V. 35 U.S.C. § 102(e).

Claims 41-45, 47, 49, and 53-56 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,190,689, (Hoffman). As to the currently rejected claims, this rejection should be withdrawn, as those claims have been canceled without prejudice or disclaimer. Furthermore, the rejection does not apply to the new claims for the following reasons.

The rejection is based upon a misunderstanding of § 102. An anticipation rejection under § 102 requires that the prior art patent described the claimed invention. 35 U.S.C. § 102(e). As used in § 102, the term "described" has a particular meaning. According to MPEP § 2131, a prior reference describes a claim of an application only if each and every element set forth in the claim is either expressly or inherently described in a single reference. This requires much more than finding each and every element in the four corners of the prior art reference: "the identical invention must be shown as complete as detailed claimed in a claim." MPEP § 2131. The references must direct those as skilled in the art to the presently claimed invention without the

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need for picking and choosing in a reference material not related to the other. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Here, for example, the Examiner refers to col. 4, line 42 where the steroid hormone (estradiol) for the treatment of osteoporosis is disclosed. The Examiner combines these teachings with those of column 8 disclosing the nature of the lipid phase which may include among other things soya bean oil, avocado oil and sterols. The need for picking and choosing clearly demonstrates that Hoffman does not disclose avocado oil/soya bean oil/sterols are effective for treatment of osteoporosis. Indeed, the only ingredient described for treatment of osteoporosis is the steroid. Furthermore, such a piecemeal disclosure does not describe any particular composition comprising avocado oil and soya bean oil, let alone avocado oil and soya bean oil components that are unsaponifiable components of avocado oil and soya bean oil. In other words, Hoffman reference fails to describe anything close to the presently claimed invention, and the rejection should not be made against the present claims.

VI. 35 U.S.C. § 103(a).

Claims 41-49 and 53-56 were rejected as obvious over the teachings of U.S. Patent No. 5,198,411 (Rancurel). As to the currently rejected claims, this rejection should be withdrawn, as those claims have been canceled without prejudice or disclaimer. Furthermore, the rejection does not apply to the new claims for the following reasons.

According to the rejection, "if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present in the functionality of the fraction H remains intact: the treatment of osteoporosis." Office action, p. 6. In other words, the rejection treats the claims as if they were directed to a product not a method.

An analysis under § 103 includes determining a scope and content of the prior art, ascertaining the differences between the prior art and claims at issue, and determining the level of

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ordinary skill in the art. *KSR International Company*, 04-1350 decided April 30, 2007, slip opinion, p. 2. Here, it is clear that the differences between Rancurel and the presently claimed invention are such that Rancurel fails to disclose any method for treating osteoporosis, let alone a method as presently claimed. Thus, the teachings of Rancurel do not render obvious an embodiment falling within the scope of the presently claimed invention, and the rejection should not be made against the present claims.

CONCLUSION

It is believed that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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Enclosures: *Farines, M. et al.*, 1995, J. of Am. Oil Chem. Soc. 72:473-76 (enclosed for consideration).